

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD E. KIDWELL

Appeal No. 97-3295
Application 08/424,759¹

ON BRIEF

Before ABRAMS, STAAB, and MCQUADE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 6-9 and 20-27, which constitute all of the claims remaining of record in the application.

¹Application for patent filed April 18, 1995.

Appeal No. 97-3295
Application No. 08/424,759

The appellant's invention is directed to a suntanning body support. The subject matter before us on appeal is illustrated by reference to claim 20, which has been reproduced in an appendix to the Brief.²

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Lerman	3,323,151	Jun. 6, 1967
Spann	3,938,205	Feb. 17, 1976
Oldfield	4,535,495	Aug. 20, 1985
De Fries	4,222,468	Sep. 16, 1980
Groenewald	5,224,226	Jul. 6, 1993

THE REJECTIONS

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 6, 8 and 20 on the basis of Groenewald and De Fries.
- (2) Claim 7 on the basis of Groenewald, De Fries and Lerman.
- (3) Claim 9 on the basis of Groenewald, De Fries and Spann.
- (4) Claims 21-24 on the basis of Spann and Groenewald.

²We note that the dependency of claim 6 is recited as being from claim 5, which has been canceled. It would appear that claim 6 should depend from claim 20. Also, as pointed out by the examiner, claim 27 was not reproduced in the appendix to the Brief.

Appeal No. 97-3295
Application No. 08/424,759

(5) Claims 25-27 on the basis of Spann, Groenewald and Oldfield.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answer and the Brief. As a result of our review, we have determined that none of the rejections should be sustained. Our reasoning is based upon the guidance from our reviewing court that in a rejection under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

The primary objective of the appellant's invention is to provide a platform for supporting a sunbather's body in positions that orient the side surfaces of the body toward the sun's rays (Brief, page 2). As manifested in all of the independent claims, the structure for accomplishing this objective comprises, *inter alia*, a body support surface which is inclined to the generally planar surface upon which it is intended to rest, and has contours conforming to the contours of the body of the sunbather. Central to our decision not to sustain the rejections is our belief that one of ordinary skill in the art would have understood from the specification that the "contours" are the undulations along the body support surface which accommodate various portions of the user's body (see Figures 1, 2 and 7), while "inclined" should be interpreted as meaning that the entire body support surface is sloped with regard to the surface upon which the elongate structure of which it is a part rests (see Figures 1, 2 and 5).

Independent claim 20 stands rejected on the basis of Groenewald in view of De Fries. From our perspective, Groenewald is the type of prior art device over which the

appellant believes his invention to be an improvement. This reference discloses a body support surface that has contours to conform to the contours of the body of the user. However, we do not agree with the examiner that the body support surface is "inclined" with respect to the planar surface that it is to rest upon, as required by the claim, considering the interpretation set forth above which we have held should be applied to this term.

The rejection of claim 20 fails at this point, for the deficiency in Groenewald is not alleviated by the teachings of De Fries. The relevance of this secondary reference extends, at most, to its teaching of providing a storage compartment in a head rest/blanket combination useable for reclining on a beach.

Thus, the combined teachings of Groenewald and De Fries fail to establish a *prima facie* case of obviousness with respect to the subject matter recited in independent claim 20, and thus the rejection of this claim and claims 6 and 8, which depend therefrom, cannot be sustained.

Adding Lerman, which is cited for its teaching of providing a cushion with an opening to function as a handle,

Appeal No. 97-3295
Application No. 08/424,759

also fails to cure the aforementioned shortcoming in Groenewald, and therefore the rejection of claim 7 also is not sustained.

Spann was added to Groenewald and De Fries in the rejection of claim 9, which requires that the elongate structure be wedge-shaped, with triangular ends. Spann is directed to a body positioner for use in supporting a patient lying upon an operating room table or the like. It comprises an elongated body having a plurality of flat surfaces upon which the patient's body can be supported (column 1, line 29 *et al.*). The ends of the body are essentially triangularly shaped. However, the mere fact that the Groenewald structure could be modified in the manner proposed by the examiner does not make such a modification obvious unless the prior art suggests the desirability of doing so (see *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). There must be a motivation stemming from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure (see, for example,

Appeal No. 97-3295
Application No. 08/424,759

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988)). We find this to be lacking.

Groenewald does not explicitly, or by implication, provide any teaching or suggestion that the body support surface disclosed should or could be used in anything other than in the orientation shown in Figures 2-4. According to Groenewald,

[t]he structure of the mattress 10 is specifically designed to provide a comfortable support to the body of a person, in particular in the lumbar regions of the body and thereby to assist in relieving lumbago pains, i.e. muscular pains in the lumbar region (column 2, lines 34-38),

which in our view would strongly indicate to one of ordinary skill in the art that it should not be inclined with respect to the surface upon which it rests. That is, it would appear from this statement that the Groenewald device would not perform its intended function if the support surface was so inclined.

For this reason, it is our opinion that there would have been no suggestion to modify the Groenewald mattress in the

Appeal No. 97-3295
Application No. 08/424,759

manner proposed by the examiner in view of the teachings of Spann, and the rejection therefore cannot be sustained.

Independent claim 21 stands rejected as being unpatentable over Spann in view of Groenewald. It is the examiner's position that it would have been obvious to one of ordinary skill in the art to contour the body support surface of Spann "to prevent the body from slipping along the inclined surface of Spann" (Answer, page 5). However, Spann utilizes all five surfaces of the body support (column 2, lines 37-41; in Figures 1-4), and teaches that "this placement of the block also provides for a wide base surface against the table with resulting increase in stability" (column 2, lines 49-51). Therefore, contouring the Spann block would seem adversely to affect the desired operation of the device, which in our view must be considered a disincentive to one of ordinary skill in the art to modify it in the manner proposed by the examiner. Thus, a *prima facie* case of obviousness is not established and the rejection of claim 21 and claims 22-24, which depend therefrom, cannot be sustained.

The same holds true of the rejection of independent claim 25 and dependent claims 26 and 27, which have been rejected on

Appeal No. 97-3295
Application No. 08/424,759

the basis of Spann in view of Groenewald and Oldfield. The latter reference, a back rest cited for its teaching of having portions of varying widths, does not overcome the problem with the basic combination.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

	Neal E. Abrams)	
	Administrative Patent Judge)	
)	
)	
)	
	Lawrence J. Staab)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	John P. McQuade)	
	Administrative Patent Judge)	

Epstein Edell & Retzer
1901 Research Boulevard
Suite 400
Rockville MD 20850-3164